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REMARKS

In the Office Action mailed January 5, 2007, the Examiner rejected claims 1, 2, 10, 11, 19, 27, 28, 36, 37, 45-47, 50, 53, and 60 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,192,980 ("Tubel") in view of U.S. Patent Pub. No. 2005/0016770 ("Mayes"). The Examiner rejected claim 48 under 35 U.S.C. § 103(a) as being unpatentable over Tubel and Mayes in further view of Applicants' prior art admission. The Examiner rejected claims 3-9, 12-18, 20-26, 29-35, 38-44, 54-59, and 61 as being unpatentable over Tubel and Mayes in further view of U.S. Patent No. 7,066,280 ("Sullivan"). Finally, the Examiner rejected claims 49, 51, and 52 under 35 U.S.C. § 103(a) as being unpatentable over Tubel and Mayes in further view of U.S. Patent No. 5,896,926 ("Hama").

Applicants respectfully traverse the rejections and submit that claims 1-61 are in condition for allowance and respectfully request notice to this effect.

Response to § 103(a) Rejections**1. Response to the Rejection under 35 U.S.C. § 103(a) Based on "Tubel" in view of "Mayes"**

The Examiner rejected claims 1, 2, 10, 11, 19, 27, 28, 36, 37, 45-47, 50, 53, and 60 under 35 U.S.C. § 103(a) as being unpatentable over Tubel in view of Mayes. However, Mayes is not prior art under 35 U.S.C. § 102. In order to support a rejection under 35 U.S.C. § 103, the reference must be available as prior art under 35 U.S.C. § 102. (See, MPEP § 2141.01(I).) The date of invention of the instant application precedes the effective date of Mayes as prior art (i.e., the filing date of July 25, 2003). Applicants submit with this Response a signed declaration pursuant to 37 C.F.R. §1.131, which

includes supporting evidence in the form of an Invention Record. Confidential information has been redacted from the Invention Record; however, as asserted in the declaration, the date of invention of the instant application precedes the priority filing date of Mayes.

Thus, as Mayes does not qualify as prior art, and standing alone Tubel does not teach or suggest all of the limitations of claims 1, 2, 10, 11, 19, 27, 28, 36, 37, 45-47, 50, 53, and 60, Applicants' respectfully request the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn.

2. Response to Claim Rejections under 35 U.S.C. § 103(a) Based on the combination of "Tubel" and "Mayes" in view of Applicants' Prior Art Admission

The Examiner rejected claim 48 under 35 U.S.C. § 103(a) as being unpatentable over Tubel and Mayes in view of Applicants' prior art admission.

Claim 48 depends from claim 46. The Examiner cites to the prior art admission for the teaching of an anechoic material coating at least a portion of the transducer. However, this teaching fails to make up for the deficiencies of Tubel and Mayes. Accordingly, Applicants also submit that claim 48 is not obvious in light of the combination of Tubel, Mayes, and Applicants' prior art admission for at least the reason described above with reference to claim 46.

In light of the above, Applicants respectfully request withdrawal of the rejection of claim 48 under 35 U.S.C. § 103(a).

3. Response to Claim Rejections under 35 U.S.C. § 103(a) Based on the combination of "Tubel" and "Mayes" in view of "Sullivan"

The Examiner rejected claims 3-9, 12-18, 20-26, 29-35, 38-44, 54-59, and 61 under 35 U.S.C. § 103(a) as being unpatentable over Tubel and Mayes in view of Sullivan.

Claims 3-9, 12-18, and 20-26 depend from claim 1. Claims 29-35 and 38-44 depend from claim 27. Claims 54-59 and 61 depend from claim 46. The Examiner cites to Sullivan for the teaching of a downhole monitoring apparatus comprising an A-D converter, multiplexer, and an amplifier coupling the sensor to the controller for converting analog signal to digital, multiplexing the input signals, and amplifying received signals of the at least one monitoring and control systems. However, these teachings fail to overcome the deficiencies of Tubel and Mayes. Accordingly, Applicants also submit that claims 3-9, 12-18, 20-26, 29-35, 38-44, 54-59, and 61 are not obvious in light of the combination of Tubel, Mayes, and Sullivan for at least the reason described above with references to claim 1, 27, and 46. In light of the above, Applicants respectfully request withdrawal of the rejection of claim 33 under 35 U.S.C. § 103(a).

4. Response to Claim Rejections under 35 U.S.C. § 103(a) Based on the combination of "Tubel" and "Mayes" in view of "Hama"

The Examiner rejected claims 49, 51, and 52 under 35 U.S.C. § 103(a) as being unpatentable over Tubel and Mayes in view of Hama. Claims 49, 51, and 52 depend from claim 46. The Examiner cited to Hama for the teaching of a downhole system that can be remotely controlled and powered from the surface unit through the use of optical fiber cable or electrical wiring. However, these teachings fail to overcome the deficiencies of Tubel and Mayes. Accordingly, Applicants also submit that claims 49, 51, and 52 are not obvious in light of the combination of Tubel, Mayes, and Hama for at least the reason described above with references to claim 46.

In light of the above, Applicants respectfully request withdrawal of the rejections of claims 49, 51, and 52 under 35 U.S.C. § 103(a).

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CONCLUSION

In light of the above amendments and remarks, Applicants submit that the present application is in condition for allowance and respectfully request notice to this effect. The Examiner is requested to contact Applicants' representative below if any questions arise or he may be of assistance to the Examiner.

Respectfully submitted,

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